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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

METZMAIER, DANIEL S

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,324

Applicant(s)

DYLLICK-BRENNINGER ET AL.

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2001 and 15 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-10 are pending. The Form PCT/DO/EO/903 mailed August 27, 2001 has been entered as Paper No. 2. Claims 11-16 were canceled and claims 3-10 were amended by the preliminary amendment filed July 24, 2001, Paper No. 3. The Information Disclosure Statement filed November 15, 2001 has been entered as Paper No. 4.

Priority

1. Receipt is acknowledged of papers received in this national stage application from the International Bureau (PCT Rule 17.2(a)), submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The specification does not include headings which are standard in U.S. Patents: Background of the Invention, Field of the Invention, Description of the Related Art, Summary of the Invention, Abstract of the Disclosure.

Appropriate correction is requested.

3. The disclosure is objected to because of the following informalities: each of the examples, 8-14, refers to properties in Table 2. Table 2 does not have any corresponding numbers to the examples 8-14. To the extent the data in Table 2 corresponds to the examples 1-7, applicants should explain how there exist two different sets of properties for the examples 1-7.

Appropriate correction is required.

Claim Objections

4. Claims 1-10 are objected to because of the following informalities: the word "deaerater" should be "deaerator". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "compounds effective as an antifoam and/or deaerator for aqueous systems", does not reasonably provide enablement for "compounds effective as an antifoam and/or deaerator for any foaming system" including lubricating oils and oil processing. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification (page 18, lines 11 et seq) sets forth the claimed compositions are very effective in aqueous systems, which tend to foam.

The claims are limited to compounds that are effective antifoam and/or deaerator agents but fail to set forth what systems said limitation "effective as an antifoam and/or deaerator" is to be evaluated. One skilled in the art would not extrapolate that compounds "effective as antifoam and/or deaerators" in aqueous systems would function as "antifoam and/or deaerators" in a nonaqueous system. Each system

requires different properties for antifoaming and/or deaerating an aqueous and non-aqueous system based on the diverse properties of the system liquid/gas interface.

One having skill in the art would not be able to determine the scope antifoam and/or deaerator nonaqueous systems, which said compounds and compositions are stated to be effective. Okumra et al, US 3,819,718 (column 4, lines 9-16), is cited as evidence of compounds having properties as foam boosters and foaming agents in some systems.

This rejection may be obviated by inserting in claim 1, line 4, after "antifoam and/or deaerator"; the phrase for aqueous systems and line 8; the phrase "in aqueous systems". Basis is found at page 18, lines 11 et seq, for said change.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is the scope of "effective as a antifoam and/or deaerator" because applicants have not defined the type of system said effectiveness is to be defined. The group of compounds and compositions defining an antifoaming and/or deaerating effect in aqueous systems would not be the same as the group defining an antifoaming and/or deaerating effect in non-aqueous systems based on the inherent differences in the liquid /gas interfaces of each system.

In claims 6 and 7, "stabilizer B" lacks proper antecedent basis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM
June 2, 2003